

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARKUS OECHSLE and FRANK WEGEHAUPT

Appeal No. 2003-0353
Application No. 09/452,157

HEARD: May 7, 2003

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6, 9 to 16, 18 to 24, 28 and 29. Claims 7, 8, 17, 25 to 27, 47, 49 to 75 and 77 have been allowed. Claims 30 to 46, 48 and 76 have been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a process as well as a system for drying a fibrous material web, in particular a paper, tissue, or cardboard web (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 6, 9 to 16, 18 to 24, 28 and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,115,741¹ to Rodi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 25, mailed August 19, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 24, filed August 5, 2002) and reply brief (Paper No. 26, filed October 21, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

¹ Issued May 26, 1992.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellants argue that the process for drying a web as set forth in the claims under appeal is not anticipated by Rodi. Specifically, the appellants point out that (1) Rodi's invention is directed to a device for drying ink printed on sheets, and (2) Rodi does not disclose a web, let alone the claimed method for drying a web. The examiner responded to this argument (i.e., that Rodi does not disclose a web) by stating that webs and sheets are equivalent subject matter.

We agree with the appellants that Rodi does not disclose a web as such term would be understood by one of ordinary skill in the art.² Therefore, the claimed subject matter (i.e., a method for drying a web) is not met by Rodi's device for drying ink printed on sheets. In our view, a web is a different article than a sheet. In that regard,

² The United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

we note that the most suitable definition of web is "a continuous sheet of paper manufactured or undergoing manufacture on a paper machine" and the most suitable definition of sheet is "a usually rectangular piece of paper; especially: one manufactured for printing."³

In the U.S. Patent Classification System, the line between Class 226, ADVANCING MATERIAL OF INDETERMINATE LENGTH, and Class 271, SHEET FEEDING OR DELIVERING, is based on disclosure of the material acted upon. Patents which clearly disclose feed or delivery of sheet-like articles only, are placed in Class 271, even though such structure is capable of feeding web material. Patents which clearly disclose movement of web material as well as sheets and claim means which is capable of moving either are placed in Class 226. Thus, the U.S. Patent Classification System clearly differentiates sheets from webs as would a person of ordinary skill in the art. While webs and sheets may be equivalent in some instances and therefore it may have been obvious at the time the invention was made to a person of ordinary skill in the art to have utilized Rodi's ink drying process on printed webs, such a modification of Rodi is only appropriate in a rejection under 35 U.S.C. § 103.⁴

³ Definitions obtained from Merriam-Webster Dictionary (<http://www.m-w.com/home.htm>).

⁴ No rejection under 35 U.S.C. § 103 is before us in this appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 9 to 16, 18 to 24, 28 and 29 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 28 and 29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Independent claim 28 is indefinite since it fails to recite a complete single sentence.⁵ In that regard, claim 28, which as currently worded recites only the same

⁵ The amendment (Paper No. 23, filed August 5, 2002) submitted to correct this error was not entered by the examiner (see answer, p. 3).

limitations as claim 10, ends not with a period but with a semicolon. Claim 29 is indefinite due to its dependency on claim 28. In addition, claim 29 is indefinite since there is no antecedent basis for "said measuring."

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 9 to 16, 18 to 24, 28 and 29 under 35 U.S.C. § 103 is reversed and a new rejection of claims 28 and 29 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED; 37 CFR § 1.196(b)

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| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
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